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10/563,164	12/27/2005	Dong-Suk Song	2150-3001-PCT	5905
35884 7590 09/02/2009 LEE, HONG, DEGERMAN, KANG & WAIMEY 660 S. FIGUEROA STREET Suite 2300 LOS ANGELES, CA 90017				
EXAMINER ROBINSON, JAMES MARSHALL				
ART UNIT		PAPER NUMBER		
3772				
NOTIFICATION DATE		DELIVERY MODE		
09/02/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/563,164

Applicant(s)

SONG, DONG-SUK

Examiner

James M. Robinson

Art Unit

3772

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This action is in response to amendments/arguments filed 5/22/2009. Currently claims 1-17 and 21-23 are pending; claims 1, 9, and 21 have been amended. Claim 23 has been added.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim limitation -- wherein the ankle protective cover has a two-folded structure such that the cushioning layer is provided between two layers of the ankle protective cover -- is indefinite. It appears that applicant is attempting to equate or in some manner relate a "two-fold" structure to a cushioning layer being between two layers of the ankle protective cover. Examiner has made a bona fide attempt to decipher the nature of the claimed two-fold cover. Examiner notes the sole disclosure of the "two-fold structure" in the Specification. Pre-grant publication of the Specification paragraph [0051] recites -- Fig. 8 shows an example where the ankle protective cover 400 has a two-fold structure, and the cushioning layer 300 is inserted between layers of the ankle protective cover 400 --. Examiner is unable to decipher a "two-fold structure" of the protective cover from any of the figures. Further, "two-fold" is ambiguous in that it connotes orders of magnitude. Although examiner does not believe applicant is attempting to claim any magnitude this is provided as an additional example

of why the claim is indefinite. As best as can be understood, in order to further prosecution, examiner interprets "two-fold structure" as broadly as their terms reasonable allow as any two folded, or two pleated, or two layered, or two creased, or any "doubled overed" structure as is reasonable in the art.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 10, 12-17, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andujar (US 5,211,672) in view of Malpee (US 5,774,898) and further in view of Andrews (US 7,107,626).

With respect to claims 1, 2, and 21 Andujar discloses foot protection device (10), comprising an exterior cover (10); an opening (12) through which a foot is inserted; an anterior hole (30) and a posterior hole (34) provided on a sole portion; and an ankle securing means (14) in the form of a slit to open and close an ankle of a user provided at an end portion of an ankle portion; an upper piece (11) covering at least an instep portion of a foot; and a lower piece (30) covering at least a sole portion of the foot.

Andujar is silent to the upper piece having first cut parts between toes; the lower piece having second cut parts between toes, including five toe insert parts with five toe holes provided on a toe portion, wherein each of the five toe holes is provided at an end

of each of the five toe insert parts wherein each of the five toe insert parts extends toward each of the five toe holes to cover at least a part of each of five toes.

However, Malpee discloses a foot protective covering comprising an upper piece (3) covering at least an instep portion of a foot and having first cut parts between toes; a lower piece (5) covering at least a sole portion of the foot and having second cut parts between toes including five toe insert parts defined at (9) with five toe holes (11) provided on a toe portion, wherein each of the five toe holes is provided at an end of each of the five toe insert parts, wherein each of the five toe insert parts extends toward each of the five toe holes to cover the toes; the entire coverage is "at least a part of each of five toes", as illustrated in figure 1.

It would have been obvious to one of ordinary skill in the art to provide the upper piece and lower piece toe areas of the Andujar device with cut parts to define five toe insert parts with five toe holes provided on a toe portion, wherein each of the five toe holes is provided at an end of each of the five toe insert parts wherein each of the five toe insert parts extends toward each of the five toe holes to cover at least a part of each of five toes as taught by Malpee in order to allow maximum movement of the muscles and joints of the foot to increase a user's agility as disclosed by Malpee in column 1, lines 8 - 12 to allow a fighter to be more agile and sure-footed.

The combination of Andujar in view of Malpee fail to disclose the five toe insert parts provided on a toe portion expose the toes.

However, Andrews discloses an exercise foot protection device including holes for each of the toes to be exposed (col 1 ln 6-10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the toe insert parts provided on a toe portion of the Andujar Malpee combination device to be open to expose the toes as taught by Andrews. Andrews provides clear motivation to ensure that an active exercise type foot protection device should maintain exposed toes in order to enhance the tack or gripping function of the toes (see Andrews abstract).

Further, Andujar discloses an instep protective cover extends toward the toe portion and the ankle portion attached to a top surface of an instep portion of the exterior cover, and an ankle protective cover attached to a top surface of the ankle portion, wherein each of the covers are composed of a polyvinylchloride coating (col 3, ln 19-22) which effectively covers the instep and ankle portions of the device; a cushioning layer (24) provided between the exterior cover and the instep protective cover in order to absorb shock; a cushioning layer (26) provided between the exterior cover and the ankle protective cover in order to absorb shock.

Andujar further discloses a coupling part (22) fixed to the ankle portion of the exterior cover; and a flap (20) extended from the coupling part to cover a portion between an instep portion and the ankle portion while the flap is not fixed to the exterior cover; an elastic band (18) provided at an end portion of the ankle portion; and fastening means in the form of VELCRO® (col 2 ln 50-56) provided on both surfaces of the elastic band; wherein the both surfaces on which the fastening means is provided fasten tightly when pressed together and are easily pulled apart by force since they are configured as hook and loop fasteners. Further, Andujar discloses wherein a cut part

(16) is provided below the elastic band where the fastening means are provided to enlarge the opening when the foot is inserted into the opening.

With respect to claim 15, Andujar fails to disclose the sides of the five toe insert parts are made of an elastic material different from that of the exterior cover such that the sides have higher elasticity than the exterior cover.

However, Malpee discloses a foot protective covering wherein the sides of the five toe insert parts made of an elastic material (25) different from that of the exterior cover such that the sides have higher elasticity than the exterior cover (col 3 ln 16-28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the toe portion of the Andujar device with five toe insert parts made of an elastic material (25) different from that of the exterior cover such that the sides have higher elasticity than the exterior cover in order to allow maximum movement of the muscles and joints of the toes of the foot to increase a user's agility as disclosed by Malpee in column 1, lines 8 - 12 to allow a fighter to be more agile and sure-footed.

With respect to claim 22, Andujar discloses wherein the ankle securing means is connected to the exterior cover by sewing or adhesive bonding (col 2 ln 50-56).

5. Claims 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andujar (US 5,211,672) in view of Malpee (US 5,774,898) in view of Andrews (US 7,107,626) and further in view of Bettencourt (US 6,058,505). Andujar/Malpee/Andrews substantially disclose the invention as claimed; see rejection to claims 1, and 4 above. Although Andujar discloses a plurality of layers, specifically a cushioning layer (26)

provided between layers of upper foam (11) and PVC coating protective cover, Andujar fails to disclose the ankle protective cover has a two-folded structure.

However, Bettencourt discloses a pad (31) for cushioning regions of the wearer from impact forces including a pocket (28) to hold the pad and a cover flap (29) which covers the upper opening of the pocket including hook and loop fastener (30) configured as a two-folded structure as best as can be understood by the examiner.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the ankle protective cover of Andujar/Malpee/Andrews with the two-folded structure taught by Bettencourt in order to allow for ready access to the cushioning layer for cleaning.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andujar (US 5,211,672) in view of Malpee (US 5,774,898) in view of Andrews (US 7,107,626) and further in view of Oh et al. (US 4,972,609). Andujar/Malpee/Andrews substantially disclose the invention as claimed; see rejection to claims 1, 3, and 5 above. Although Andujar/Malpee disclose holes to allow continuous ventilation, they are silent to air holes provided specifically on the cushioning layer at the instep.

However, Oh et al. discloses a protective shoe for use in the martial arts including instep air holes (48) provided on the cushioning layer.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the cushioning layer of Andujar/Malpee/Andrews with air holes as taught by Oh to permit air to circulate inside the device upper (Oh et al., col 3 ln 27-29).

Response to Arguments

7. Applicant's arguments with respect to claims 1, 9, and 21 have been considered but are moot in view of the new ground(s) of rejection. Examiner appreciates the concise and direct nature of applicant's arguments.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Robinson whose telephone number is (571) 270-3867. The examiner can normally be reached on Mon-Fri 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571)272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James M. Robinson/

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/Patricia Bianco/
Supervisory Patent Examiner, Art Unit 3772